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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,635	08/02/1999	PAUL JAMES CONROY	72005-7	6737

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EXAMINER

MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/09/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/355,635	Applicant(s) CONROY ET AL.	
	Examiner Michael C. Miggins	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 20-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION**

**Election/Restrictions**

1. In response to applicant's letter received on 12/11/01, all the office action of 9/11/01 has been withdrawn in its entirety. Consequently, applicant has elected group I, claims 1-19 for examination and claims 20-29 have been withdrawn from consideration.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because claim 1 recites a method claim but does not set forth a series of positive manipulative steps but rather sets forth mere statements of desired results, specifically "...comprising applying to the surface...", such a limitation should be written as a manipulative step. Furthermore, the term applying is indefinite because it is unclear to one of ordinary skill in the art whether the composition is applied as a coating, or sprayed etc., appropriate correction is required. Moreover, the phrase "...acts as a low leaching coating..." is indefinite because it is unclear whether the coating is a low leaching coating or not, appropriate correction is required.

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The term "low" in claim 1 is a relative term which renders the claim indefinite. The term "low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 2 is indefinite for containing the term "free lime", while lime is an art recognized term referring to calcium oxide, the term "free lime" is not an art recognized term and the specification does not describe the scope of the term free lime. Moreover, the phrase, "...capable of..." is indefinite because it is not clear to one of ordinary skill in the art whether the at least one cement and component reacts or does not react with the free lime.

The term "highly" in claim 3 is a relative term which renders the claim indefinite. The term "highly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 8-11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Heitzmann et al. (WO 89/02878).

Heitzmann et al. teach a method of protecting a surface from corrosion, comprising applying to the surface a cementitious composition comprising at least one cement in combination with metakaolin, comprising not more than 10 parts by weight metakaolin, further comprising a cement replacement material in an amount of not more than 70 parts by weight, based on the dry composition, wherein the cement replacement material is ground granulated blast furnace slag and/or pulverized fuel ash and sand (abstract, page 3 and examples 1-2) (applies to instant claims 1-6, 8-11 and 16).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heitzmann et al. (WO 89/02878) in view of Allen et al. (WO 95/11863).

Heitzmann et al. teach a cementitious composition comprising at least one cement in combination with metakaolin, comprising not more than 30 parts by weight metakaolin, further comprising a cement replacement material in an amount of not more than 70 parts by weight, based on the dry composition, wherein the cement replacement material is ground granulated blast furnace slag and/or pulverized fuel ash

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and sand (abstract, page 3 and examples 1-2) (applies to instant claims 1-6, 8-11 and 16).

Heitzmann et al. disclose applicant's invention substantially as claimed. However, Heitzmann et al. fail to teach the claimed composition further comprising aggregate and/or fibre reinforcement and a pipe comprising a hollow metallic conduit and coating provided on an internal and/or external surface to the conduit, wherein the coating comprises applicant's claimed composition and wherein said cementitious composition is hardened after application to a surface.

Allen et al. teach a cementitious composition composition further comprising aggregate and/or fibre reinforcement and a pipe comprising a hollow metallic conduit and coating provided on an internal and/or external surface to the conduit, wherein the coating comprises said cementitious composition made from Portland cement for the purpose of providing improved cracking resistance and wherein said cementitious composition is hardened after application to a surface (abstract, page 1, lines 20-25, page 3) (applies to instant claims 12-13 and 17-19).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided aggregate and/or fibre reinforcement and a pipe comprising a hollow metallic conduit and coating provided on an internal and/or external surface to the conduit and wherein said cementitious composition is hardened after application to a surface in the method of Heitzmann et al. in order to provide improved cracking resistance as taught by Allen et al..

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The combined teachings of Heitzmann et al. and Allen et al. disclose the claimed invention except for the parts pozzolan and parts water recited in the claims 7 and 14-15. Achieving the claimed parts pozzolan and parts water would have been routine optimization of a result effective variable. *In re Aller*, 105 USPQ 233 and *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MCM   
August 27, 2002

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

9/4/02